

REMARKS:

The Office Action dated May 15, 2008, has been received and carefully reviewed. The preceding amendments and the following remarks form a full and complete response thereto. Claims 10-13 are amended. Support for the amendments can be found, inter alia, at Figs. 4a-d of the present application. No new matter is added or amendments made that raise issues that require further consideration or search. Thus, entry and consideration of the amendments is earnestly requested.

Claims 2-8 and 10-15 are pending in the application and submitted for reconsideration.

Applicant's representative thanks the Examiner, and his supervisor, for extending the courtesy to conduct a telephonic interview on July 25, 2008.

An objection was made to claims 10-12 because of informalities. Regarding claims 10-11, at step (c), the term "seperating" is amended to – separating--. Regarding claim 12, line 1, the claim is amended to refer to claim 13. Accordingly, Applicant requests that the objections be withdrawn.

The following prior art rejections were brought:

- Claims 2, 6, 8, 10 and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,620,547 issued to Boebel;
- Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boebel in view of U.S. Patent No. 5,106,364 issued to Hayafuji et al;
- Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boebel in view of Lifton '753;

- Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boebel in view of U.S. Patent No. 4,254,762 issued to Yoon;
- Claims 7 and 14-15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boebel in view of U.S. Patent Publication No. 2003/0181823 issued to Gatto;
- Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boebel in view of U.S. Patent No. 4,702,260 issued to Wang; and
- Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boebel in view of U.S. Patent No. 6,217,598 issued to Berman et al.

Applicant respectfully traverses each of the rejections and submits that claims 2-8 and 10-15 recite subject matter not disclosed or suggested by any of the above-listed combinations of cited prior art.

In the interview, the Boebel reference – the central reference to each prior art rejection -- was discussed at length. It was agreed that Boebel fails to disclose or suggest the features of the present invention relating to the use of a cannula having at least one lateral opening in a side surface of the cannula being inserted into the body (such as into a milk duct), having an endoscope being axially movable inside the cannula, wherein a clearance is formed between the cannula and the endoscope such that a separation of a tissue sample from a tissue is enabled by direct interaction of the optical end of the endoscope with the at least one lateral opening, by moving at least one of the cannula and the endoscope relative to each other. For example, see Figs. 4a-4d which illustrate a cannula having a lateral opening that acts as a cutter to cut a

tissue sample when the optical end (which may be a dull or blunt end) of the endoscope directly interacts therewith.

Boebel describes the following:

The inner shaft 5 which comprises an optical system 7, which has a lateral objective.... the cutter 6 is joined fixedly or releasably to the untwistable and axially displaceable inner shaft 5

See column 2, lines 24-34 (emphasis added). Based on this language, the Office apparently takes the position that the cutter 6 and the shaft 5 are one piece and that the inner shaft 5 comprises the optical system 7, thereby the components 5, 6, 7 combine to be part of an endoscope. While the Applicant disagrees with this characterization of the prior art and asserts again that the endoscope is the optical system 7, even considering items 5-7 to be an endoscope, Boebel fails to disclose that the optical end of the endoscope interacts with a lateral opening of the cannula. Instead, in Boebel, a cutting blade 6 is provided that is attached to the endoscope for cutting tissue. The endoscope does not itself (i.e., the optical end thereof) interact with the lateral opening as required by each of the independent claims of the present application. Thus, Boebel fails to disclose or suggest each and every element of claims 2-8 and 10-15.

None of the other cited references disclose such a feature and therefore, none of the additional prior art reference can remedy the deficiencies of Boebel. The combination of cited prior art fails to disclose or suggest each and every element of claims 2-8 and 10-15. Accordingly, each of the rejections is improper and must be withdrawn.

In view of the above, all objections and rejections have been sufficiently addressed. The Applicant submits that the application is now in condition for allowance and requests that claims 2-8 and 10-15 be allowed and this application passed to issue.

In the event that this paper is not timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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